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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,602	10/03/2000	Jun Ueki	0760-0281P	7119

2292 7590 12/31/2001

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EXAMINER

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,602

Applicant(s)

UEKI, JUN

Examiner

Bronwen M. Loeb

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-14,16-18 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-14,16-18 and 21-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 15.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is a Supplemental Action to the action mailed 2 October 2001, which was in response to the amendment filed June 28, 2001, in which claims 3, 8, 15, 19 and 20 were cancelled, claims 1, 2, 4, 6, 7, 9-14 and 16-18 were amended and new claims 21-32 were submitted.

Applicant's request for reconsideration of the finality of the rejection of the last Office action, said request made during the telephonic interview made of record as Paper #15, is persuasive and, therefore, the finality of that action is withdrawn.

Claims 1, 2, 4-7, 9-14, 16-18 and 21-32 are pending.

Response to Amendment

1. Claims 1, 2, 4, 6, 7, 13 and 14, and extended to new claims 26, 28 and 29, stand rejected under 35 U.S.C. §102(e) as being anticipated by Morioka et al for reasons of record and as further discussed below.

Claims 1, 2, 4-7, 13 and 14, and extended to new claims 21, 22, 26, 28 and 29, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morioka et al in view of Ueki et al (Plant Cell Physiol. (1999) 40(6): 618-623) for reasons of record and as further discussed below.

Claims 1, 2, 4-7, 13 and 14, and extended to new claims 21, 22, 26, 28 and 29, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morioka et al, in view of Ueki et al (EP 0846770 A1; "Ueki et al EP") for reasons of record and as further discussed below.

2. New grounds for rejection are presented below.

Response to Arguments

3. With respect to the rejection of claims 1, 2, 4, 6, 7, 13, 14, 26, 28 and 29 under 35 U.S.C. §102(e) as being anticipated by Morioka et al, Applicant' arguments filed June 28, 2001 have been fully considered but they are not deemed to be persuasive.

Applicant argues that by amending the independent claims 1, 6 and 13 to incorporate the limitation of claim 3, the rejections of the claims over the prior art is overcome. This is not found persuasive as the limitation of claim 3 was incorporated into the respective independent claims only with respect to the first species claimed. Therefore, the second species is still anticipated by Morioka et al and the rejection is maintained.

4. With respect to the rejection of claims 1, 2, 4-7, 13, 14, 21, 22, 26, 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Morioka et al, in view of Ueki et al (Plant Cell Physiol. (1999) 40(6): 618-623), Applicant' arguments filed June 28, 2001 have been fully considered but they are not deemed to be persuasive.

Applicant argues that by amending the independent claims 1, 6 and 13 to incorporate the limitation of claim 3, the rejections of the claims over the prior art is overcome. There is no argument specifically addressing this obviousness rejection. Therefore, this is not found persuasive as the limitation of claim 3 was incorporated into the respective independent claims only with respect to the first species claimed. The

Art Unit: 1636

second species is still anticipated by Morioka et al and the obviousness rejection is maintained.

5. With respect to the rejection of claims 1, 2, 4-7, 13, 14, 21, 22, 26, 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Morioka et al, in view of Ueki et al (EP 0846770 A1; "Ueki et al EP"), Applicant' arguments filed June 28, 2001 have been fully considered but they are not deemed to be persuasive.

Applicant argues that by amending the independent claims 1, 6 and 13 to incorporate the limitation of claim 3, the rejections of the claims over the prior art is overcome. There is no argument specifically addressing this obviousness rejection. Therefore, this is not found persuasive as the limitation of claim 3 was incorporated into the respective independent claims only with respect to the first species claimed. The second species is still anticipated by Morioka et al and the obviousness rejection is maintained.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 2, 4-7, 9-14, 16-18 and 21-32 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in

Art Unit: 1636

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is based on the Revised Interim Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, first paragraph "Written Description" Requirement published in the Federal Register (Volume 64, Number 244, Pages 71427-71440). Claim 1 is drawn to an isolated nucleic acid comprising the same nucleotide sequence shown in SEQ ID No.1 except that one or a plurality of nucleotides are substituted or deleted, or except that one or a plurality of nucleotides are inserted or added, which has activity to promote expression of a structural gene located downstream of said nucleic acid fragment. This is a genus claim in terms of any substitution, any deletion, any insertion or any addition to SEQ ID No. 1 which has promoter activity. Claim 13 is drawn to a method for promoting expression of a structural gene which employs an isolated nucleic acid comprising the same nucleotide sequence shown in SEQ ID No.1 except that one or a plurality of nucleotides are substituted or deleted, or except that one or a plurality of nucleotides are inserted or added, which has activity to promote expression of a structural gene located downstream of said nucleic acid fragment. This is a genus claim in terms of any substitution, any deletion, any insertion or any addition to SEQ ID No. 1 which has promoter activity. The specification mentions only SEQ ID No. 1, without any internal deletions, substitutions or additions. This disclosure is not deemed to be descriptive of the complete structure of a representative number of species encompassed by the

Art Unit: 1636

claims as one of skill in the art cannot envision all of the possible isolated nucleic acids based on the teachings in the specification. The specification does not teach which nucleotides are the basis for the promoter function within SEQ ID No. 1 so there is no structure-function correlation taught. Furthermore, there are no teachings regarding where insertions may be made or where deletions may be made within SEQ ID No. 1 and still have it maintain promoter activity. Therefore, the specification does not describe the claimed genus of isolated nucleic acids in such full, clear, concise and exact terms so as to indicate that Applicant has possession of these isolated nucleic acids at the time of filing the present application. Thus, the written description requirement has not been satisfied.

8. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 24 and 25 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 25 are vague and indefinite in reciting "is inserted upstream of said structural gene". It is unclear with respect to the intron insertion recited in claim 17, upon which both of these claims depend, where the plurality is inserted.

Art Unit: 1636

Conclusion

Claims 1, 2, 4-7, 9-14, 16-18 and 21-32 are rejected. Claims 9-12, 16-18, 23-25, 27 and 30-32 are free of prior art.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 10:00 AM to 6:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to Dianiece Jacobs, Patent Analyst whose telephone number is (703) 305-3388.

Bronwen M. Loeb, Ph.D.
Patent Examiner
Art Unit 1636

December 20, 2001


REMY YUCEL, PH.D.
PRIMARY EXAMINER